

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-4, 6-8, 12, 13, 48 and 49 are pending in the application, with claims 1, 3, 6, 12, 13, 48 and 49 being the independent claims. Claims 1-4, 6, 7, 8, 12, and 13 are sought to be amended. Claims 12 and 13 are amended to be independent claims incorporating subject matter from the base claim into the dependent claims. Claims 5, 9-11 and 14 are sought to be cancelled without prejudice or disclaimer of the subject matter therein. Applicants reserve the right to prosecute similar or broader claims, with respect to the cancelled and amended claims, in the future. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 112

Claims 1-2

Claims 1-2 were rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. *Office Action*, p. 3. Specifically, it is alleged that "the 'if' statement (recited in the last step of claim 1) renders the claim indefinite because it connotes optional language whereby the limitation potentially and alternative is not required to perform the limitation." *Id.* Applicants respectfully traverse this rejection.

Without conceding the propriety of the rejection, and solely to further prosecution of this matter, Applicants have amended claim 1. Accordingly, Applicants respectfully request that the rejection of claims 1 and 2 be reconsidered and withdrawn.

Claim 48

Claim 48 was rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. *Office Action*, p. 3. Specifically, it is alleged that the written description fails to disclose the corresponding structure, material or acts for the claim elements of "means for receiving," "means for generating," and "means for printing." *Id.* Applicants respectfully traverse this rejection.

With respect to the claim element "means for receiving information that includes an ABA number of a bank, a customer account number, an n-digit personal code, and a key," the corresponding structure, material or acts is disclosed in a number of places in the specification, including, e.g., *Specification*, p. 13, para. [0035].

With respect to the claim element "means for generating a p-bit hash value based on the information," the corresponding structure, material or acts is disclosed in a number of places in the specification, including, e.g., *Specification*, p. 13, para. [0036].

With respect to the claim element "means for printing the ABA number, the customer account number, and the p-bit hash value on a MICR line of a check," the corresponding structure, material or acts is disclosed in a number of places in the specification, including, e.g., *Specification*, p. 14, para. [0038].

Accordingly, Applicants respectfully request that the rejection of claim 48 be withdrawn.

Rejections under 35 U.S.C. § 101

Claims 1-2

Claims 1-2 were rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. *Office Action*, pp. 5-6. Specifically, it is alleged that these claims do not qualify as a statutory process since "they are not tied to a machine." *Office Action*, p. 6. Without conceding the propriety of this rejection, and solely to advance prosecution of this matter, Applicants have amended claim 1 to clarify tying of the method steps to a machine. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1 and 2.

Claims 6-8

Claims 6-8 were rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. *Office Action*, p. 5. Specifically, it is alleged that the instruction is "not clearly [a] computer executable instruction." *Id.* Without conceding the propriety of this rejection, and solely to advance prosecution of this matter, Applicants have amended claims 6 and 7 to recite "computer executable instructions." Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 6-8.

Rejections under 35 U.S.C. § 103

Claims 3-5, 9-14 and 49 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,611,598 to Hayosh ("*Hayosh*"). Applicants respectfully traverse the rejection and the Response to Arguments on page 2 of the Office Action.

Without acquiescing to the propriety of the rejection, and for other reasons, claims 5, 9-11 and 14 have been cancelled, rendering their rejections as moot.

Claims 12-13 have been rewritten in independent form to include subject matter from their respective base claim, claim 10.

Independent claim 3 recites, among other things:

a receiver, wherein the receiver is programmed to receive information representative of a MICR line that includes data representative of an ABA number of a bank and a customer account number; and

a check printer, wherein the check printer is programmed to print the information on a check MICR line and to print a p-bit hash value on the check MICR line based on the information, an n digit personal code, and a key.

Independent claims 12, 13, and 49 recite similar features, using respective language.

Specifically, the Examiner states the recited terms "adapted to" and "configured to" result in a recitation of "an intended use." *Office Action*, p. 7. In addition, the Examiner states that "*Hayosh's* computer is capable of receiving, printing and verifying the hash value containing in the MICR line of a check." *Id.* at pages 2 and 7. The

Examiner further states that "it would have been obvious to one with ordinary skill in the art at the time the invention was made to **modify** Hayosh's to include the feature above for the purpose of enhancing the security in processing a check." *Id.* (*emphasis added*). In providing case law justification, *In re Schreiber* is noted by the Examiner, namely: "[t]he recitation of a new intended use for an old product does not make a claim to that old product patentable." Finally, it is alleged that "a recitation of the intended use of a claim must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." *Office Action*, p. 2. Applicants respectfully traverse these statements.

First, in an Examiner's note, it is asserted that the alleged intended use claim language can be avoided by using terms such as "receiving" "printing" and "verifying." *Office Action*, p. 8. However, the Examiner's recommended claim language of "a receiver receiving checks, a check printer printing the information, [and] a check verifier verifying checks" *may* be seen by some courts as being invalid under 35 U.S.C. §§ 101 and 112, under some Federal Circuit case law. *See, e.g., IPXL Holdings v. Amazon.com*, 430 F.2d 1377, 1384 (Fed. Cir. 2005) (holding that that reciting both an apparatus and a method of using that apparatus renders a claim indefinite). Accordingly, while Applicants appreciate the Examiner's suggestion, Applicants decline to make the recommended changes.

Second, the claim language "adapted to" and "configured" (and now "programmed to") is not an intended use, but positively recites the structure of particular elements in the claims, which must be given patentable weight. As recently confirmed by the Federal Circuit, all words of a claim must be given patentable weight, including

functional recitations in a non means-plus-function apparatus claim. *Microprocessor Enhancement Corp. v. Texas Instruments, Inc.*, 520 F.3d 1367 (Fed. Cir. 2008) (holding functional features following a 'capable of' clause in a software claim were positively recited features that required being given patentable weight); *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999) (analyzing functional language as an additional limitation to an apparatus claim for an in-line skate). For example, a recitation of a check printer "programmed to print the information on a check MICR line and to print a p-bit hash value on the check MICR line" does not merely describe a use, but positively recites that the printer must be constructed or programmed to "print the information on a check MICR line and to print a p-bit hash value on the check MICR line." Similarly, a recitation of a receiver "programmed to receive information representative of a MICR line that includes data representative of an ABA number of a bank and a customer account number" also positively recites that the receiver must be constructed to or programmed to "receive [the] information." Not just any printer or receiver is being recited, nor is an intended use being described. Instead, in the pending claims, the recited elements describe a receiver and a printer whose structure prints the "p-bit hash value on the check MICR line" and receives the recited "information."

Third, the Examiner alleges through its reference to *In re Schrieber* that the claims is merely "a new intended use" for an old product, i.e., a *Hayosh* printer. Even assuming *arguendo* that "a new intended use" is a valid basis for rejection of the claims, which Applicants do not acquiesce to, Applicants contend that the "old product" (the *Hayosh* printer) is simply not capable of printing the "p-bit hash value on the MICR line." In particular, *Hayosh* does not disclose a "hash value." Moreover, the Office

Action acknowledges that *Hayosh* is not capable of performing the recited elements by stating the need to "**modify** Hayosh's to include the feature above." *Office Action*, p. 7 (*emphasis added*). Thus, the Examiner in effect concedes that *Hayosh* is not the "old product" necessary for the *In re Schreiber* case law to apply. Given such a concession by the Examiner, the Examiner cannot then state the printer is not an "old product," and therefore the alleged "intended use" basis for the rejection cannot be maintained.

Finally, the Examiner alleges that "it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Hayosh's printer to include the feature above for the purpose of enhancing the security in processing a check." *Office Action*, p. 7. However, in making this rejection, no reason is articulated by the Examiner as to why one of ordinary skill in the art, familiar with *Hayosh*, would make the modification that is allegedly obvious. Significantly, *Hayosh* discloses no information concerning the use of a personal code, nor the hashing function applied to various parameters, including the ABA account and personal code. Instead, *Hayosh* discloses the generation of a laser-printed 2-D symbol and the associated authentication of the data contained in a document. Given that *Hayosh* does not provide any such disclosure or reason to support the required modification, the obviousness rejection lacks the required articulate reasoning.

When determining whether a claim is obvious, an Examiner must make "a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (*emphasis added*). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Int'l. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*,

Reply to Office Action of July 20, 2009

490 F.2d 981, 985 (CCPA 1974)). Furthermore, as the Supreme Court recently stated, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)). Applicants further disagree with the Examiner's improper conclusory statement. In *KSR* the Court noted that "[t]o facilitate review, this analysis should be made explicit." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")). *Id.* Further, it appears the Examiner is relying on improper speculation of what the reference *may* be teaching in the conclusory statements. In an exemplary post-KSR BPAI decision, *Ex Parte Kamran Ahmed*, Appeal 2007-2765, App. 09/526,442, Decided Feb. 11, 1008 at page 6, the Board opined "Further, a rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. 'Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand.' (quoting *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967)). See also *In re Kahn*, 441 F.3d at 988." Also, on page 10 of *Ex Parte Ahmed*, the Board held the Examiner relied on improper speculation, and reversed the obviousness rejection. Finally, the Supreme Court also confirmed that, "[a] fact finder should be aware, of course, of the distinction caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007).

The *Hayosh* reference lacks the disclosure of a personal code or the hashing function. Absent such a disclosure or reason for the Examiner's proposed modification, there is no rational underpinning to support the alleged legal conclusion of obviousness. Rather, it appears the Examiner has used improper speculation or hindsight to arrive at the conclusory statements.

Accordingly, since the applied reference cannot be used to establish a *prima facie* case of obviousness, Applicants respectfully request the reconsideration and withdrawal of the rejection of independent claims 3, 12, 13, and 49.

Applicants contend that dependent claim 4 is patentable for the reasons that the independent claim 3 is patentable, and further in view of its own particular features. Accordingly, Applicants respectfully request the withdrawal of the rejection of dependent claim 4.

Double Patenting

Claim 48 is objected to under 37 C.F.R. § 1.75 as allegedly being a substantial duplicate of claim 49. Specifically, it is alleged that claims 48 and 49 "are duplicates or ... are so close in content that they both cover the same thing." *Office Action, p. 3*. Applicants respectfully traverse this objection.

Claim 48 is a system claim comprising elements recited as means-plus-functions claims, e.g., "means for receiving," "means for generating" and "means for printing," which are interpreted in the light of the specification under the provisions of 35 U.S.C. § 112 para. 6. In contrast, Claim 49 is a different claim type, and recites a system claim comprising the elements of "a receiver," "a p-bit hash value processor" and "a check

printer," which are broadly interpreted. Because the scopes of these two claim types are interpreted under different statutory and case law requirements, the claim types are not co-extensive in scope. Accordingly, claims 48 and 49 cannot be duplicates as these claims have at least a "mere difference in scope" pursuant to M.P.E.P. § 706.03(k). Therefore, Applicants respectfully request the withdrawal of the objection.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Reply to Office Action of July 20, 2009

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Appl. No. 09/901,124

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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